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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,768	07/24/2001	Kenkou Yamaura	31721-174066	3574

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EXAMINER

BOVEJA, NAMRATA

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/910,768

Applicant(s)

YAMAURA, KENKOU

Examiner

Namrata Boveja

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. This office action is in response to communication filed on 01/05/2006.
2. Claims 1-4 have been cancelled by the Applicant. Claims 5-7 are presented for examination.
3. Amendments to claims 5-7 have been entered and considered.

#### **Claim Rejections - 35 USC § 112**

4. The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

(A) the claims must set forth the subject matter that applicants regard as their invention; and

(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, "sending mail server settings within said terminal device are rewritten as the mail server of said server device" is incomprehensible, and thus no prior art can be applied to this limitation as there is substantial doubt as to the scope of this limitation.

#### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless - (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than

one year prior to the date of application for patent in the United States.

5. Claims 5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Sugimoto Hideo et al. (Patent Number JP 11-242714 hereinafter Hideo).

Hideo teaches a homepage access system using lottery numbered e-mails (*i.e. greeting cards with lottery numbers*), said system being used for accessing a server device having a homepage for providing a mail sending/receiving service to a terminal device over a network, said server device comprising: (a) means for starting up a mailer of said server device by said terminal device accessing said homepage and a sender clicking on a predetermined button on said homepage (*page 16, paragraph 1, lines 1-18, and Figure 2*); (b) means for instructing that the sender will create an e-mail by the start up of said mailer (*page 16, paragraph 1-3, lines 1-41, and Figures 2 and 3*); (c) means for determining the suitability of the e-mail upon completion of creating the e-mail (*Figure 11, item 806 and associated text: a card cannot be sent to and from a same address and page 23, paragraph 2, lines 1-11*); (d) means for writing at the end of the e-mail a lottery number (*Figure 17 items (c) and (e) which show a message addressed to the recipient's e-mail address including a prize lottery number*) and an address of said homepage (*Figure 2 item (i) that recites a webpage address for accessing the sent greeting card and accompanying lottery number*), and further attaching a notification of a drawing thereto and sending the e-mail to an e-mail address of the an e-mail recipient (*Figure 7 lines 6-9 that gives notification of when the prize lottery will be held and when the results can be known*), in the event that said determining means determines the e-mail to be suitable; (e) means for saving said

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lottery number and said *e-mail address of the e-mail recipient* to a file within the server device at the time of sending the e-mail to the e-mail recipient (*page 19, paragraph 4, lines 3-10 and Figures 3 and 15 which illustrate that the information to be stored in server system prize lottery database includes entrance ID number or the prize lottery number and the recipient's e-mail address*); (f) means for performing processing for randomly determining a winning lottery number from said saved lottery numbers (*page 21 paragraph 2, lines 8-10 where the server randomly determines a winning lottery number to determine winners of premiums, where the premiums are simply the prizes of the underlying lottery program*); and (g) means for matching an e-mail address input by said e-mail recipient with the lottery number and e-mail address of said e-mail recipient saved in said file, in the event that said e-mail recipient accesses the address of said homepage written in the sent e-mail and checks winning of the lottery number, so as to check the identification of a winner (*page 20, paragraph 14, lines 1 to page 21, paragraph 15 lines 10 and Figures 5 and 14 where it is recited that the server creates a personal web page after it determines the e-mail address and password (or other specific ID) of the sender or the receiver and displays whether the sender and receiver have won or lost the lottery for premiums by having identified the winner's identity through the e-mail address and password information previously*).

6. In reference to claim 7, Hideo teaches a homepage access system using lottery numbered e-mails, wherein said server device has an original mailer set so as to be capable of accessing said homepage for sending/receiving e-mails, said server device comprising: means for displaying a mailer download screen upon a *receiving* terminal

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device *to* access an original mailer download request, instructing input of required items, and registering the necessary items in a user registration file upon completion of input of the required items, and downloading said original mailer (*page 13 , paragraph 6, line 1 to page 15 paragraph 4 line 20* and Figure 1).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hideo in view of Official Notice.

In reference to claim 6, Hideo explicitly or at least implicitly discloses wherein, upon a user registration request from said terminal device, said server device displays a user registration screen and instructs input of required items, and wherein, upon the user making input according to said instructions, said required items are stored in a user registration file (see at least Figures 1-5 and associated text).

As to "the user of said registration request is provided with a nickname, and the user of said registration request is notified of the nickname." Hideo does not specifically disclose these *steps*. However, Official Notice is taken that these steps are well known and practiced in case a nickname is desired to be used. It would have been obvious to one skilled in the art at the time the invention was made to add the above well-practiced

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steps to Hideo to implement the process as is ordinarily done in case a nickname is desired to be used.

**Response to Arguments**

8. After careful review of Applicant's remarks/arguments filed on 01/05/2006, the examiner fully considered the arguments, but they are not persuasive.

9. Applicant did not address one of the 35 U.S.C. 112 issues that were pointed out in the prior Office Action, and therefore, the 35 U.S.C. 112 rejection is maintained for claim 6 and has been removed for successfully addressing the issues with claims 5 and 7 respectively.

10. Applicant argues that the claimed invention and the invention described by Hideo are completely different in their fundamental concepts. Specifically, the Applicant argues that the claimed system related to a typical e-mail system including a single sender and a single receiver, whereas the Hideo system related to a single transmitting person (i.e. a sender) sending an e-mail greeting card to many addresses (i.e. receivers). The Examiner respectfully disagrees in that both the Applicant system and the Hideo system relate to e-mail systems. Furthermore, the Hideo system indeed teaches a single sender sending an e-mail to a single receiver (page 10 paragraph 4 lines 1-3).

11. In reference to claim 5, Applicant argues that this claim is distinguished from Hideo for at least five reasons. First, the Applicant argues that Hideo does not show a checking system or means to determine whether an e-mail address is invalid per claim element (c). Examiner would like to point the Applicant to Hideo page 23, paragraph 2,

lines 1-11 where Hideo clearly recites that e-mails sent to invalid addresses are prevented by sending and tracking a confirmation mail to the sender. If the confirmation mail is returned for any reason (such as if the mail server determines the address is incorrect), the system determines that this address is possibly incorrect, and the user cannot create a new e-mail greeting card using that e-mail address. Applicant also argues that receivers in Hideo's invention do not receive a lottery number. Examiner again respectfully disagrees with the Applicant and would like to point to Figure 17 items (c) and (e) which show a message addressed to the recipient's e-mail address including a prize lottery number.

Second, the Applicant argues that in element (d) of the claim, a lottery number, an address of the homepage, and a notification of a drawing are sent to the recipient, and that Hideo does not teach these three things. Examiner respectfully disagrees with the Applicant, and would like to point the Applicant to Figure 17 items (c) and (e) which show a message addressed to the recipient's e-mail address including a prize lottery number, Figure 2 item (i) that recites a webpage address for accessing the sent greeting card and accompanying lottery number, and Figure 7 lines 6-9 that gives notification of when the prize lottery will be held and when the results can be known.

Third, the Applicant argues that in regards to element (e), Hideo does not teach saving the lottery number and the e-mail address of the recipients in the server. Examiner respectfully disagrees and would like to point the Applicant to page 19, paragraph 4, lines 3-10 and Figures 3 and 15 which illustrate that the information to be



stored in server system prize lottery database includes entrance ID number or the prize lottery number and the recipient's e-mail address.

Fourth, the Applicant argues that in regards to element (f), in the Applicant's invention, the server randomly determines a winning lottery number from the saved lottery numbers, but in Hideo's invention, the server searches the database of the system to randomly determine winners of premiums based on the participant who transmitted or received the greeting card. The Examiner would like to point out to the Applicant that Hideo's invention still reads on the Applicant's invention in that in both cases the server randomly determines a winning lottery number (page 21 paragraph 2, lines 8-10), where Hideo recites that random electronic selection is done to determine winners of premiums, where the premiums are simply the prizes of the underlying lottery program.

Fifth, the Applicant argues that in regards to element (g) [applicant had a typographical error in the arguments and stated (e), but the Examiner has addressed the limitation addressed in the argument by the Applicant and has determined that the Applicant meant (g) instead of (e) in order to move the prosecution along in the case], the Hideo system does not have any means for checking for winner identification. Examiner respectfully disagrees with the Applicant, and would like to point the Applicant to page 20, paragraph 14, lines 1 to page 21, paragraph 15 lines 10 and Figures 5 and 14. Specifically, on pages 20 and 21, it is recited that the server creates a personal web page after it determines the e-mail address and password (or other specific ID) of the sender or the receiver and displays whether the sender and receiver have won or lost

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the lottery for premiums by having identified the winner's identity through the e-mail address and password information previously.

12. The rejection for remaining claims 6 and 7 is maintained for similar reasons as those highlighted above for claim 5 and in the detailed action above.

**Point of contact**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The Central FAX Number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

N.B.

March 16<sup>th</sup>, 2006

  
**RETTA YEHEDEGA**  
**PRIMARY EXAMINER**